

DT04 Rec'd PCT/PTO 12 NOV 2003

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jean-Claude Basset  
5 Ser. No.: 09/980,389  
Filed: November 29, 2001  
PCT No.: PCT/FR00/01464  
Intl Filing: May, 29, 2000  
For: Communication Installation for Collective Data Reception

10 RENEWED PETITION UNDER 37 CFR 1.47(b) FOR ACCEPTANCE OF  
APPLICATION WITHOUT PARTICIPATION OF INVENTOR

15 Hon. Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

20 Responsive to the Decision to the Petition under 37 CFR 1.47(b) dated  
May 14, 2003, the following Renewed Petition is hereby submitted. A Petition  
for Extension of Time, extending the deadline for responding to the Decision  
to expire on November 14, 2003, is attached herewith.

25 The Decision notes that the previous Petition fails to:

1. provide an affidavit or declaration of the facts upon which the  
conclusion that Mr. Basset refused to execute the application papers;
2. provide an oath or declaration that states the relationship of the  
30 person making the declaration to the inventor;
3. provide evidence of ownership per 37 CFR 3.73(b)(1); and
4. provide evidence of applicant's sufficient proprietary interest in  
35 the application.

The following Exhibits are attached in support of the Renewed Petition:

40 G. declaration by Frederique Dersoir, Foreign Filing Manager,  
Thomson Inc., of the facts upon which the conclusion that Mr. Basset refused  
to execute the application papers is based;

45 H. declaration signed by Joseph S. Tripoli, Senior Vice President  
Thomson Multimedia Licensing, Inc., on behalf of Thomson Multimedia Digital  
France, for Mr. Basset, wherein the required relationship is indicated on the  
declaration;

50 I. statement, and translation, from the Human Resources  
Manager of Thales e-Transaction, S.A., attesting that Mr. Basset was  
employed by the company, which was formerly called D.A.T., from the period  
September 19, 1973 to May 7, 2000;

J. statement, and translation, from the Human Resources Manager of Thales e-Transaction, S.A., attesting that Thales e-Transaction, S.A., was previously called Electronique Marcel Dassault, and D.A.T.;

K. copy, and translation, of the offer of employment by which Mr. Basset was employed by Electronique Marcel Dassault;

L. copy of French Law, Article L611-7, pertaining to the right of title to Industrial Property;

M. declaration by Brigitte Ruellan, a licensed French Patent Attorney and European Patent Attorney, attesting that in her expert opinion, under French Law, in view of Article L611-7 and the exhibits presented in the Petition and the Renewed Petition, D.A.T. acquired sufficient proprietary interest in the present patent application; and

N. certified copy of the priority document, and the translation of the document, evidencing that the priority document is the same as the present application.

With regard to item (1), the necessary declaration is submitted as Exhibit G.

With regard to item (2), the necessary declaration is submitted as Exhibit H. Section 409.03(b) of the MPEP states that

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation

As stated in the Petition filed on July 17, 2002, in view of Exhibit F, Joseph S. Tripoli is authorized to sign requisite documents in proceedings concerning this patent application on behalf of Thomson Multimedia Digital France. In view of the above, it is submitted that the statement of relationship is satisfied by the indication that Joseph S. Tripoli is an officer authorized to sign on behalf of Thomson Multimedia Digital France.

With regard to items (3) and (4), it is submitted that Exhibits I-N satisfy the requirement of providing evidence of ownership or sufficient proprietary interest.

Section 409.03(f) of the MPEP states:

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

As indicated by Exhibits I-N, it is submitted that under French Law D.A.T. acquired sufficient proprietary interest in the priority document. It is also submitted that in view of Exhibit E, which was submitted with the Petition filed on July 17, 2002, Petitioner has proprietary interest in the priority document, and the present application. Regarding the rights in the PCT application, Exhibit E, clause 2.1, paragraph 9, states "patent applications' shall mean French patent applications as listed in Annex 1C, as well as any future patent applications filed abroad, whether or not they are subject to the priority of the said French patent applications. (emphasis added)" In view of the above, it is submitted that Petitioner has sufficient proprietary interest in the PCT application and the present application.

As indicated by Exhibit N, the disclosure of the priority document is the same as the present invention.

Regarding 37 CFR 3.73 (b), Petitioner respectfully submits that the statement is not applicable to, and need not be submitted in the present application since there is neither a recorded assignment from the inventor nor a recorded chain of title for this application.

In view of the above, it is respectfully requested that the present  
Renewed Petition be granted and that the enclosed Declaration document  
executed by Joseph S. Tripoli be accepted as satisfying the requirements of  
37 C.F.R. 1.497(a) and (b), and that the subject Patent Application be made  
on behalf of J.C. Basset.

Please charge the fee associated with this Petition to Deposit Account  
07-0832. Should any questions arise regarding any of the above, the  
Examiner is requested to contact the undersigned at 609-734-6815.

Respectfully submitted,



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Paul P. Kiel  
Attorney for Applicant  
Registration No. 40,677

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jean-Claude Basset  
Ser. No.: 09/980,389  
5 Filed: May 29, 2000  
For: COMMUNICATION INSTALLATION FOR COLLECTIVE  
DATA RECEPTION

DECLARATION

10 Hon. Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

I, Frederique Dersoir, declare the following.

15 I am a Foreign Filing Manager for Thomson, S.A., in Paris, France. I have  
been employed as the Foreign Filing Manager for Thomson, S.A. for the past seven  
years. My duties as the Foreign Filing Manager include preparing and forwarding to  
Foreign Patent Agents instructions and documents for filing new patent applications,  
and obtaining the necessary signatures for documents required for foreign filing.

20 I handled the processing of the inventor's declaration for the present  
Application. As shown in Exhibit A, I sent e-mails to Mr. Basset on November 28,  
2001, December 13, 2001, and December 18, 2001, requesting that Mr. Basset sign  
and return the declaration. Mr. Basset's response to my e-mail requests is included in  
Exhibits A and B. I also prepared and sent, on January 15, 2002, via registered mail,  
25 the letter shown in Exhibit C. I subsequently prepared and sent, on March 19, 2002,  
via registered mail, the reminder letter shown in Exhibit D. Proper receipt of the letter  
sent March 19, 2002, is evidenced by the signed receipt. I have not received a  
response to either registered letter. In view of the fact that numerous requests have  
been made to Mr. Basset, that Mr. Basset has acknowledged our e-mail requests and  
30 received our registered letters, and that Mr. Basset while responding to the earlier e-  
mail requests has not responded to our letters, I believe that Mr. Basset has evidenced  
an unwillingness to sign the requested documents.



35  
40  
Frederique Dersoir,  
Foreign Filing Manager  
European Patent Operations  
Thomson, S.A.

Exhibit I

THALES

EXHIBIT G

**THALES e-TRANSACTIONS**

9, rue Elsa Triolet - ZI des Gâtines - BP 13  
78373 Plaisir Cedex  
FRANCE  
Tél. : +33 (0)1 30 81 20 00  
Fax : +33 (0)1 30 55 19 31  
www.thalesgroup.com

**ATTESTATION**

Je soussignée Florence GALLOIS, Responsable Ressources Humaines de  
Thales e-Transactions S.A., certifie que Monsieur Jean-Claude BASSET a bien été  
employé par la Société dénommée alors Dassault A.T., du 19 septembre 1973 au  
7 mai 2000.



Fait à Plaisir,

Le 26 novembre 2002

# THALES

**THALES e-TRANSACTIONS**

9, rue Elsa Triolet - ZI des Gâtines - BP 13

78373 Plaisir Cedex

FRANCE

Tel.: +33 (0) 1 30 81 20 00

Fax: +33 (0) 1 30 55 19 31

[www.thalesgroup.com](http://www.thalesgroup.com)

## CERTIFICATE

I, the undersigned Florence GALLOIS, Human Resources Manager at Thales e-Transactions S.A., certify that Mr Jean-Claude BASSET was employed by the Company at the time called Dassault A.T., from 19 September 1973 to 7 May 2000.

[signature]

Plaisir,

26 November 2002

**THALES e-TRANSACTIONS S.A.**

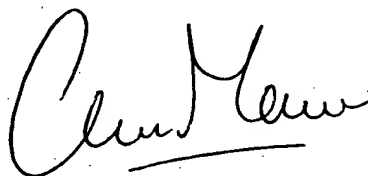
Limited liability company with a capital of 30,600,000 Euro

RCS Versailles B 380 248 609

Exhibit J

I, Clive Edward MANN BA,  
translator to RWS Group plc, of Europa House, Marsham Way, Gerrards Cross,  
Buckinghamshire, England, hereby declare that I am conversant with the English and French  
languages and am a competent translator thereof. I declare further that to the best of my  
knowledge and belief the following is a true and correct translation of the accompanying  
document in the French language.

Signed this 6th day of February 2003

A handwritten signature in black ink, appearing to read 'Clive Mann', with a horizontal line underneath the name.

C. E. MANN

For and on behalf of RWS Group plc



# THALES

## **THALES e-TRANSACTIONS**

9, rue Elsa Triolet - ZI des Gâtines - BP 13

78373 Plaisir Cedex

FRANCE

Tel.: +33 (0) 1 30 81 20 00

Fax: +33 (0) 1 30 55 19 31

[www.thalesgroup.com](http://www.thalesgroup.com)

## **CERTIFICATE**

I, the undersigned Florence GALLOIS, Human Resources Manager at Thales e-Transactions S.A., certify that the name of our company has successively been:

- Electronique Marcel Dassault,
- becoming Electronique Serge Dassault,
- Dassault Electronique,
- Dassault Automatismes et Télécommunications,
- and now Thales e-Transactions S.A.

Plaisir,

3 February 2003

[signature]

## **THALES e-TRANSACTIONS S.A.**

Limited liability company with a capital of 30,600,000 Euro

RCS Versailles B 380 248 609

# THALES

**THALES e-TRANSACTIONS**

9, rue Elsa Triolet - 21 des Gâtines - BP 13

78373 Plaisir Cedex

FRANCE

Tél. : +33 (0)1 30 81 20 00

Fax : +33 (0)1 30 55 19 31

www.thalesgroup.com

## ATTESTATION

Je soussignée Florence GALLOIS, Responsable Ressources Humaines de  
Thales e-Transactions S.A., certifie que la dénomination de notre société a été  
successivement :

- Electronique Marcel Dassault,
- devenue Electronique Serge Dassault,
- Dassault Electronique,
- Dassault Automatismes et Télécommunications,
- et actuellement Thales e-Transactions S.A.

Fait à Plaisir,  
Le 3 février 2003



Exhibit K

EXHIBIT I

**ELECTRONIQUE MARCEL DASSAULT**

Société Anonyme au Capital de 25 000 000 F  
55, QUAI CARNOT - 92214 - SAINT-CLOUD - TEL 602.60.00

Adresse Rég. : ELECTRODASSAULT

Télex : 25.767 F - E. M. D. SCLOU

Boite Postale N° 41. 92214 - St-Cloud

Service du Personnel

Saint-Cloud, le 19 Septembre 1972

GD/SC - n° 4.921

Dossier n° 11.209

Monsieur Jean-Claude BASSET

84, rue Vergaude

75013 PARIS

Monsieur,

Nous avons le plaisir de vous informer que nous sommes disposés à vous engager à l'ELECTRONIQUE MARCEL DASSAULT, en qualité de :

**" INGENIEUR Position III A "**

sous les appointements mensuels et forfaitaires de **FRANCS** (FRANCS), sans notion d'horaire, sous réserve du résultat satisfaisant de l'examen médical d'usage que vous aurez à passer ultérieurement et au plus tard le jour de votre entrée en fonctions.

De votre rémunération seront à déduire, pour les parts vous incombant, les cotisations prévues au titre des divers régimes applicables (Sécurité Sociale, A. S. S. E. D. I. C. , I. P. E. C. A. etc. . . ), du fait des dispositions légales, conventionnelles ou propres à la Société.

Il est bien entendu que les trois premiers mois de votre présence seront considérés comme période d'essai au cours de laquelle chacune des parties pourra reprendre sa liberté selon les modalités de l'Article 8 de la Convention Collective du 13 Mars 1972.

L'Entreprise travaillant presque exclusivement pour la Défense Nationale, l'engagement ne sera définitif qu'après accord de la Délégation Ministérielle pour l'Armement.

.../...

BEST AVAILABLE COPY

GD/SC - n° 4.521

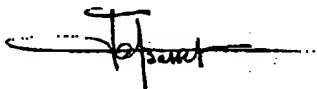
- 2 -

Vous prendrez vos fonctions dès que possible et au plus tard le  
**MARDI 2 JANVIER 1974.**

Nous vous demandons de nous faire connaître votre acceptation à ces conditions avant le 15 OCTOBRE 1973, ainsi que la date approximative de votre entrée en fonctions, en nous retournant le double de la présente lettre datée, signée et revêtue de la mention manuscrite "Lu et Approuvé".

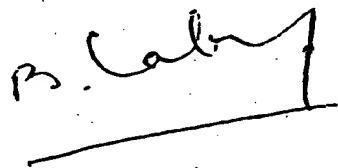
Nous vous prions d'agréer, Monsieur, l'expression de nos sentiments distingués.

Lu et Approuvé



Paris le 10 octobre 1973.

Le Directeur Général Adjoint,  
**B. LABEY.**



**P. J. :**

Un exemplaire de la présente lettre à nous retourner datée et revêtue de votre signature précédée de la mention manuscrite "Lu et Approuvé". -

BEST AVAILABLE COPY

**ELECTRONIQUE MARCEL DASSAULT**  
*Société Anonyme with a Capital of FF 25,000,000*  
55, QUAI CARNOT 92214 - SAINT-CLOUD TEL. 602.50.00

Personnel Department  
GD/SC - No. 4.521

Saint-Cloud, 19 September

File No. 11.209

Mr Jean-Claude BASSET  
84, rue Vergniaud  
75013 PARIS

Dear Sir,

We are pleased to inform you that we wish to offer you the post at ELECTRONIQUE MARCEL DASSAULT of:

"Position III A ENGINEER"

for a monthly flat-rate salary of                      FRANCS (                      francs), without hours being stipulated, subject to your passing the usual medical examination which you must take in due course and no later than the day you start work.

On the basis of legal, contractual or internal provisions, contributions specified under the various applicable regulations (Social Security, A.S.S.E.D.I.C. [Association for Industrial and Commercial Employment], I.P.E.C.A. [Provident Institution for Aeronautical Construction Companies], etc.) shall be deducted from your pay in the proportions payable by you.

It is understood that the first three months you are at the company will be regarded as a trial period during which each of the parties may freely withdraw from the contract according to the terms of Article 5 of the Collective Agreement of 13 March 1972.

As the company works almost exclusively for National Defence, the appointment will only be final after agreement by the Ministerial Delegation for Armaments.

You are to start work as soon as possible and no later than TUESDAY 2 JANUARY 1974.

Please let us know whether you accept under the above terms by 15 OCTOBER 1973, and the approximate date you will be able to start by returning the copy of this letter dated, signed and bearing the written words "Read and Approved".

Yours faithfully,

*Read and Approved*  
*[Signature]*  
*Paris, 10 October 1973*

Assistant Managing Director  
B. LABEY  
[Signature]

Enclosed:

A copy of this letter to be returned dated and bearing your signature after the written words "Read and Approved".

**BEST AVAILABLE COPY**

INTELLECTUAL PROPERTY CODE (Legislative Part)  
Second part; Industrial property  
Book VI; Protection of technical knowledge and inventions  
Title I; Patents of invention  
Chapter I; Field of application  
Section 2: Right to title

EXHIBIT J

**Article L611-7**

*(Act No. 94-102 of 5 February 1994, Art. 22, Official Journal of 8 February 1994)*

If the inventor is an employee, the right to title of industrial property, failing a contractual stipulation more favourable for the employee, is defined according to the following provisions:

1. Inventions made by the employee in the performance either of an employment contract including inventive work which corresponds to his actual functions, or of studies and research explicitly conferred upon him, belong to the employer. The terms under which the employee who has produced such an invention benefits from an additional settlement are determined by collective agreements, company agreements and individual employment contracts.

If the employer is not subject to an industry collective agreement, any dispute relating to the additional settlement is referred to the conciliation board instituted by Article L. 615-21 or to the high court:

2. All other inventions belong to the employee. However, where an invention is produced by an employee either during the performance of his functions or in the field of activity of the company or through the knowledge or use of techniques or means specific to the company, or of information obtained by it, the employer has the right, in accordance with the terms and the time periods set by order of the Council of State, to take ownership or possession of all or part of the rights attached to the patent protecting its employee's invention.

The employee must obtain a fair price for the invention which, if the parties fail to reach an agreement, is set by the conciliation board instituted by Article L. 615-21 or by the high court; the latter shall take into consideration all evidence submitted to them, in particular by the employer and by the employee, in order to calculate a fair price both as a function of the initial contributions of each party and of the industrial and commercial usefulness of the invention.

3. The employee who has produced the invention informs his employer thereof, and the employer acknowledges receipt in accordance with the statutory terms and time periods.

The employee and the employer must communicate to each other any useful information on the invention in question. They must refrain from disclosing any information which might breach all or some of the rights conferred by this book.

Any agreement between the employee and his employer regarding an invention by an employee must be in writing, otherwise it is null and void.

4. The terms implementing this article are laid down by order of the Council of State.

5. The provisions of this article also apply to agents of the State, public bodies and any other legal persons under public law, according to the terms laid down by order of the Council of State.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jean-Claude Basset  
Ser. No.: 09/980,389  
5 Filed: May 29, 2000  
For: COMMUNICATION INSTALLATION FOR COLLECTIVE  
DATA RECEPTION

DECLARATION

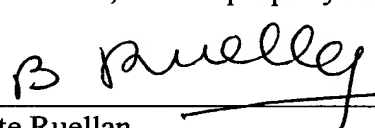
10 Hon. Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

I, Brigitte Ruellan, declare the following.

15 I am a licensed French Patent Attorney and European patent attorney. I have  
been practicing patent law for 28 years, and have expert knowledge of French and  
European patent laws. I am currently employed by Thomson, S.A., as a managing  
patent attorney, managing the activities of 4 patent attorneys in the Paris Office. My  
duties include managing these attorneys in the prosecution of patent applications  
20 worldwide including, in the French Patent Office INPI, Institut National de la  
Propriete Industrielle and the European Patent Office, and in providing licensing  
support for a worldwide licensing organization. I also manage my own docket of  
patent applications and provide licensing support in the areas of LCD and other  
displays. Prior to my employment with Thomson, S.A., I was employed by a French  
25 private law firm as a Patent Engineer.

I have reviewed the present application and documents relating to the present  
application, including the Petition under 37 CFR 1.47 filed in the USPTO on July 17,  
2002, the present Renewed Petition, and the Exhibits included with the Petitions.  
Based on the above, I conclude that under French Law, specifically Article L611-7,  
30 and the applicable cases, and in view of his employment as an engineer with D.A.T.,  
which resulted in the filing of the priority document, D.A.T. properly acquired rights  
to the priority document from Mr. Basset.

  
35 Brigitte Ruellan,  
European Patent Attorney  
Manager, Patent Operations  
Thomson, S.A.